Supreme Court, U.S.
FILED
APR 20 1988
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No. 87-1592

IN THE

Supreme Court of the United States

OCTOBER TERM, 1987

KYOCERA INTERNATIONAL, INC.
and KYOTO CERAMIC CO., LTD.,

Petitioners,

v.

KENNECOTT CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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COUNTERSTATEMENT OF QUESTION PRESENTED

As stated by the petitioners, the question presented is seriously flawed, particularly in its opening clause which states, "[w]here it is admittedly impossible to discern the invention from a reading of a patent . . ." In fact, the invention is clearly identified and described in the parent '954 patent. All that the present controversy concerns is the admitted absence from the '954 patent of an express identification of an inherent property of the invention, namely, an equiaxed microstructure. Remarkably, the petitioners completely omit from their statement of the question presented and, for that matter, from their entire petition, any mention of the doctrine of inherency, the principal basis of the Federal Circuit's decision. Accurately stated, the question presented is as follows:

Did the Federal Circuit correctly find that the express disclosure in a subsequent patent application of an inherent property of a product disclosed in an earlier related patent application does not deprive the product of the benefit of the filing date of the earlier application, nor does the inclusion of a description of that property in later-filed claims change this result?

RULE 34.1(b) STATEMENT

Kennecott Corporation, the nominal respondent, was a real party in interest at the time the district court entered judgment in 1986, but it is no longer a real party in interest. Effective as of December 31, 1986, the name of Kennecott Corporation was changed to Kennecott Mining Corporation, and all assets of Kennecott Corporation which pertain to this suit were transferred to Stemcor Corporation, a Delaware corporation. As owner of the patents in suit, Stemcor Corporation is now a real party in interest.*

RULE 28.1 STATEMENT

Stemcor Corporation is now owned 99% by Standard Alaska Production Company, a Delaware Corporation, and 1% by The Standard Oil Co., an Ohio corporation. Standard Alaska Production Company is a wholly-owned subsidiary of The Standard Oil Co. The Standard Oil Co. is a wholly-owned subsidiary of BP America, Inc., a Delaware corporation. BP America, Inc. is a wholly-owned subsidiary of The British Petroleum Co. p.l.c., a British Company.

Stemcor Corporation has no subsidiaries or affiliates, other than subsidiaries which are directly or indirectly wholly owned. Stemcor Corporation is in the process of changing its name to The Carborundum Company.

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* Effective as of May 7, 1987, the name of Kennecott Mining Corporation was changed to Industrial Holdings Corporation, and Industrial Holdings Corporation was sold to Shearson Lehman Brothers Holdings, Inc. Industrial Holdings Corporation is now a wholly-owned subsidiary of Shearson Lehman Brothers Holdings, Inc.

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RESPONDENT'S BRIEF IN OPPOSITION

Respondent Kennecott Corporation respectfully requests that this Court deny the petition for a writ of certiorari, which seeks review of the judgment and opinion of the United States Court of Appeals for the Federal Circuit, reported at 835 F.2d 1419 and reprinted in the Appendix to the petition as Appendix B.[1]

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[1] The Appendix attached to the petition is referred to in this brief as "App. ____", and the petition itself is referred to as "Pet. at ____".

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

In addition to the sections of the Patent Statute reproduced in the Appendix (App. G), the following portions of the Constitution and the Patent Statute are relevant here:

U.S. Const. art. I, § 8, cl. 8

> The Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; . . . .

35 U.S.C. § 282

Presumption of validity; defenses

> A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity . . . .

COUNTERSTATEMENT OF THE CASE

A. Background Of The Patents Involved

The application for U.S. Patent No. 4,312,954 ("the '954 patent"), owned by respondent Kennecott Corporation ("Kennecott"),[2] was filed on June 5, 1975. It disclosed the invention of a sintered silicon carbide ceramic body. The application for the related U.S. Patent No. 4,179,299 ("the '299 patent"), also owned by Kennecott, was filed on May 1, 1978, and was designated a continuation-in-part ("CIP") of the '954 patent application. The CIP application also disclosed the invention of a sintered silicon carbide ceramic body. One of the ways that it differed from its parent application was that the CIP application expressly drew attention to the inherent property of an equiaxed microstructure.

B. The Proceedings In The District Court

Kennecott commenced this action against the petitioners herein, Kyocera International, Inc. and Kyoto Ceramic Co., Ltd. (collectively, "Kyocera"), asserting infringement of both the '954 patent and the '299 patent. In its defense, Kyocera claimed that the '299 patent is invalid under 35 U.S.C. § 102(b).[3]

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[2] For a complete explanation of the ownership of title to the patents in suit, please refer to the statements in compliance with Rules 34.1(b) and 28.1, included at page ii of this brief. All of the interested parties on behalf of respondent are collectively referred to herein as "Kennecott".

[3] § 102(b) provides that a patent is invalid if the invention disclosed therein was on sale in this country more than one year prior to the filing date of the patent. (App. G1)

The only way that Kyocera could prevail on this defense was to prove that the '299 patent was not entitled to an effective filing date of June 5, 1975, the date that the application for the '954 patent was filed. This, in turn, required that Kyocera show that the property of an equiaxed microstructure was not described in the parent application in accordance with the description of the invention requirement of 35 U.S.C. § 112 ("the description requirement").[4]

Kyocera moved and petitioned for reconsideration *three* times before finally, on the fourth try, it convinced the district court to rule in its favor on the filing date issue. However, in doing so the district court acknowledged that, "I wouldn't be surprised that some court, somewhere, will tell me that I'm all wet." (Tr. Nov. 17, 1986, p. 8, lines 23-25) Nonetheless, the court found that the effective filing date of the '299 patent was May 1, 1978, not June 5, 1975.

In light of this ruling, Kennecott filed an admission that prior to May 1, 1977 (i.e., more than one year prior to what was found to be the effective filing date of the '299 patent), Kennecott offered for sale and sold in the United States silicon carbide ceramic bodies manufactured in accordance with one or more of examples 1-30 of the '954 patent and falling within the scope of the claims of the '299 patent. Accordingly, the district court entered summary judgment that the claims of the '299 patent were invalid under § 102(b).

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[4] § 112 provides, *inter alia*, that the specification of a patent shall contain a "written description of the invention . . ." (App. G3)

C. The Federal Circuit's Reversal Of The District Court

In its decision reversing the ruling of the district court, the Federal Circuit pointed to five key facts that are admitted:

> 1. the pertinent silicon carbide ceramic body described in the application for the '954 patent has an equiaxed microstructure;
>
> 2. the application for the '954 patent does not mention the equiaxed microstructure property or state the requirements for forming such a microstructure;[5]
>
> 3. the Kennecott inventors knew that the pertinent ceramic body disclosed in the application for the '954 patent had an equiaxed microstructure, and it was known that such ceramics could have such a microstructure;
>
> 4. examples 1-30 in the application for the '954 patent each produces a ceramic body having an equiaxed microstructure; and
>
> 5. the method set forth in the application for the '954 patent using the pertinent silicon carbide invariably produces a ceramic body having an equiaxed microstructure. (App. B4)[6]

---

[5] Kennecott does not admit that the requirements for forming an equiaxed microstructure are not stated in the application for the '954 patent. They are stated in examples 1-30 set forth therein, each of which, if repeated, invariably produces a silicon carbide ceramic body having an equiaxed microstructure.

[6] The Federal Circuit's recitation of these five important facts identified the pertinent ceramic body as one that is "high-alpha" silicon carbide. This is to distinguish from lower-alpha or beta silicon carbide, which are not part of the preferred embodiment or examples 1-30 of the '954 patent.

The Federal Circuit rejected the district court's reading into § 112 of the limitation that "to meet the description requirement, one reading the specification must know from the 'four corners' of the document, without recourse to information outside the specification, that the ceramic body has an equiaxed microstructure." (App. B5) The appellate court noted that, "[t]he Court of Customs and Patent Appeals [the Federal Circuit's predecessor court] [("CCPA")] has long recognized that an invention may be described in different ways and still be the same invention." (App. B9)

One of these different ways is through what is known as an inherent disclosure. For example, in *In re Nathan*, 328 F.2d 1005 (C.C.P.A. 1964), "the court held that the later-added limitation to the claims of the compound's alpha orientation was 'an inherent characteristic' of the claimed subject matter, and reversed a new matter rejection." (App. B9) Based upon *Nathan* and other applicable precedent, the Federal Circuit concluded as follows:

> In the case at bar the additional description [of an equiaxed microstructure] was not of a new use, but of the existing physical structure of the product. On the basis of this precedent, the inclusion of the existing microstructure as a descriptive term in the '299 claims does not cause the '299 claims to lose their entitlement to the date of the first-filed '954 application. (App. B10)

In summary, the court emphasized that the doctrine of inherency applies to the determination of whether the description requirement of § 112 is satisfied:

> The disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result. (App. B11)

The Federal Circuit panel unanimously reversed the district court's grant of summary judgment, concluding that the district court erred in holding that the '299 claims were not entitled to the filing date of the '954 patent. (App. B11) Kyocera petitioned the Federal Circuit to reconsider, en banc, its decision. This petition was summarily denied after briefing by both parties. (App. F1-F2)

SUMMARY OF REASONS FOR DENYING THE WRIT

Kyocera's petition asks this Court to exercise its certiorari jurisdiction to review a decision that was carefully considered and correctly decided. Applying the well-established doctrine of inherency, the Federal Circuit correctly held that an inherent disclosure of a property of an invention fully satisfies the description requirement, so that a subsequent express disclosure of the property is entitled to the original filing date.

The courts have repeatedly recognized that description requirement questions are particularly fact-intensive. Therefore, this Court's consideration of the description requirement on the facts of this case would offer little guidance to the lower courts. In addition, the courts have had no trouble in applying the doctrine of inherency to description requirement questions, nor have they disagreed on its application in such circumstances. This Court should not waste its scarce resources on the limited and unimportant question posed here.

There is no conflict between the Federal Circuit's decision here and any of the Supreme Court cases or the

CCPA decision relied upon by Kyocera. The cited cases of this Court were decided long before § 112 was enacted, and, as will be illustrated at length hereafter, they are otherwise inapposite. Likewise, the CCPA decision is distinguishable both on the law and on its facts.

The Federal Circuit reached a fair result in according the '299 patent the filing date of the '954 patent. In order to encourage and stimulate invention, inventors must not be straitjacketed by unduly restrictive disclosure requirements. The doctrine of inherency ensures that the public interest underlying the description requirement is satisfied, while it also allows inventors necessary latitude in disclosing their inventions. Indeed, another result here would create chaos in patent law and effectively destroy the doctrine of inherency.

The lack of merit in Kyocera's petition is perhaps best illustrated by the deficiencies of its own brief, beginning with the erroneous premise that the invention is not described in the '954 patent. Furthermore, Kyocera's attempt to read a "four corners" restriction into the express language of § 112 has no foundation, and its attempt to assign the purpose of § 112 as a whole to the description requirement alone is in error. The ultimate deficiency is Kyocera's failure to discuss the doctrine of inherency, the express basis of the Federal Circuit's decision.

Kyocera has shown dauntless persistency with respect to this question by filing multiple motions and petitions for reconsideration. Its petition here represents yet another attempt to argue a narrow and simple question that was correctly decided by the Federal Circuit and is not worthy of this Court's time and consideration. The writ should be denied.

REASONS FOR DENYING THE WRIT

A. The Federal Circuit Reached A Correct Conclusion That Is In Accord With An Established Line Of Precedent

The description requirement is one of three requirements of the first paragraph of § 112.[7] The description requirement ensures "that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351 (C.C.P.A. 1978). Compliance with the requirement is judged "from the perspective of the person skilled in the relevant art." *In re Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973).

Because there is an infinite variety of ways in which an invention may be "described", the law is well-settled that the inventor's possession of his invention may be conveyed "in any way" to those skilled in the art. *In re Smythe*, 480 F.2d 1376, 1382 (C.C.P.A. 1973). *See also In re Voss*, 557 F.2d 812, 817 (C.C.P.A. 1977) ("How the application of the parent achieves compliance [with the description requirement] is immaterial.")

One of the ways in which the specification may describe the invention is, of course, by an express disclosure. In addition, however, an inherent disclosure of an invention

[7] The other requirements are known as the enablement and best mode requirements, each of which concerns a different aspect of disclosure. However, although Kyocera's petition tends to gloss over this fact, as the Federal Circuit explained in this case, "[t]he purpose of the description requirement . . . is to state what is needed to fulfill the enablement criteria. These requirements may be viewed separately, but they are intertwined." (B6)

equally satisfies the description requirement. The cases that apply the so-called doctrine of inherency to the description requirement are legion. Among the most pertinent here are those cases relied upon by the Federal Circuit in its thoughtful analysis of the issue before it, including, *In re Nathan*, 328 F.2d 1005 (C.C.P.A. 1964) (App. B9); *In re Reynolds*, 443 F.2d 384 (C.C.P.A. 1971) (App. B8); and *Edwards*, 568 F.2d at 1349 (App. B7-B8).

Another apt case, having facts very analogous to those at bar, is the decision of the Ninth Circuit in *Indiana General Corp. v. Lockheed Aircraft Corp.*, 408 F.2d 294 (9th Cir. 1968). The invention disclosed in the parent application in *Indiana General* embodied a method for making a manganese-magnesium ferrite material. Although the application included examples of how to make the material, it did not mention one of its properties, a square hysteresis loop. This property was subsequently expressly described in a CIP application. *Id.* at 299. In the interim between the filing of the parent and the CIP applications, the patentee sold products covering the invention, including the square hysteresis loop. The asserted claims of the CIP were held invalid on a motion for summary judgment because the lower court did not accord the CIP application the filing date of the parent. *Id.* at 295-96. The Ninth Circuit reversed for the same reasons that the Federal Circuit did so here:

> The fact that an inventor of a specific compound subsequently discloses in a continuation in part application an additional property or use of the compound or composition does not deprive the inventor of the filing date of the first application disclosing the compound . . . . The properties of a given substance are immutable.

Id. at 298-99. *See also In re Magerlein*, 346 F.2d 609, 611-12 (C.C.P.A. 1965); *Ralston Purina Co. v. Far-Mar-Co*,

Inc., 586 F. Supp. 1176, 1220 (D. Kan. 1984), *modified on other grounds*, 772 F.2d 1570 (Fed. Cir. 1985).

Ignoring all of this sound precedent and all of the compelling reasons advanced by the Federal Circuit as to why Kyocera's arguments lack merit, Kyocera hinges its petition on its oft-repeated argument that the description requirement mandates that the invention be described within the "four corners" of the patent. This argument is as deficient now as it was when Kyocera first asserted it. As noted hereinbefore, the invention of a silicon carbide ceramic body *is* expressly described within the "four corners" of the '954 patent; all that is at issue is the description of the equiaxed microstructure. The equiaxed microstructure also *is* described within the "four corners" of the '954 patent; however, it is inherently, rather than expressly, described.

With respect to the Patent Statute, this Court has been particularly careful to caution that, "courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.' " *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (construing § 101 of the Statute and quoting *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 199 (1933)). A plain reading of § 112 illustrates that there is *no* "four corners" limitation in the description requirement. Thus, Kyocera's argument to the contrary (Pet. at 14-16) is wholly devoid of merit.[8]

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[8] Kyocera's repeated references to § 102(b) and its purpose is a red herring (e.g., Pet. at 15) because the Federal Circuit's decision in no way compromises the purpose of § 102(b). Indeed, Kennecott's allegedly invalidating sales of ceramic bodies, which were manufactured in accordance with the preferred teachings and examples 1-30 of the '954 patent, were made *after* the application for the '954 patent was filed and *before* the application for the '299 patent existed.

Indeed, there is ample judicial authority for looking beyond the "four corners" of a patent when considering whether the description requirement is satisfied.[9] *In re Edwards*, 568 F.2d at 1352-54 (inferences that could be drawn from examples in application); *Standard Oil Co. (Indiana) v. Montedison, S.p.A.*, 664 F.2d 356, 371 (3d Cir. 1981), *cert. denied*, 456 U.S. 915 (1982) (examination of results obtained by following examples set forth in application); *In re Voss*, 557 F.2d at 818 (consideration of findings made in third party civil litigation); *In re Nathan*, 328 F.2d at 1008-09 (use of affidavit which described result obtained by following example set forth in application).

The reason for this clear authority is simple. By definition, an inherent description is not an express one. Thus, an inherent description, such as of an "equiaxed microstructure", requires that the invention be described in a manner *other than express language*, because if there were an express disclosure, the issue of inherency would not need to be considered. The Federal Circuit had before it a classic case for applying the doctrine of inherency, and it correctly followed established precedent in deciding the description requirement question.

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[9] Similarly, the law is well-settled that the enablement requirement of § 112 is satisfied even though reasonable experimentation may be necessary. *See e.g., DeGeorge v. Bernier*, 768 F.2d 1318, 1323 (Fed. Cir. 1985). In this case, *no* experimentation is necessary to obtain a silicon carbide ceramic body having an equiaxed microstructure. And as the Federal Circuit pointed out in this case, the description and enablement requirements "may be viewed separately, but they are intertwined." (App. B6) *See also In re Barker*, 559 F.2d 588, 594 (C.C.P.A. 1977), *cert. denied*, 434 U.S. 1064 (1978) (Rich, J., concurring) (description and enablement are "distinct though commingled requirements").

B. The Question Presented Is Not An Important One

By the very nature of the inquiry, each description question turns on its own specific facts. *In re Edwards*, 568 F.2d 1349, 1352 (C.C.P.A. 1978). The pertinent language of § 112 is very broad: ". . . a written description of the invention", no doubt to accommodate the variety of ways by which the description requirement may be satisfied. *See Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (stating that "Congress plainly contemplated that the patent laws would be given wide scope" in using broad terms to define patentable subject matter).

In recognition of the flexible approach that must be taken with description questions, the Federal Circuit has stated that, "Precisely how close the original description must come to comply with the description requirement of 35 U.S.C. § 112 must be determined on a case-by-case basis." *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985). Because of this limitation, the courts have long noted that decisions on description requirement questions are of limited precedential value. *In re Driscoll*, 562 F.2d 1245, 1250 (C.C.P.A. 1977).

In view of the fact-intensive nature of description questions, even if this Court were to consider this case on its undisputed facts, the Court's decision would be of limited direction to the lower courts. In addition, the lower courts have not had any disagreement among themselves as to how the description requirement may be satisfied, nor have they indicated that this Court's intervention is necessary to resolve confusion or difficulty on their part.

Accordingly, the Court's consideration of this narrow question, lacking in importance, would constitute a waste of this Court's already scarce resources.

C. The Decision Below Does Not Conflict With Decisions Of This Court Or Precedent In The Federal Circuit

Arguing that the Federal Circuit's decision is at odds with judicial precedent, Kyocera cites three decisions by this Court, each at least 50 years old, and one decision of the CCPA. Kyocera has only now raised the Supreme Court cases, none of which is on point. In fact, no reported decision of the Federal Circuit cites any of these cases in deciding a description requirement issue. In its discussion of the cases, Kyocera itself equivocally contends that there "appears" to be an inconsistency with the Federal Circuit's decision. (Pet. at 16, 18) Clearly, even Kyocera realizes that its argument lacks merit.

Permutit Co. v. Graver Corp., 284 U.S. 52 (1931), was decided over twenty years before the enactment of the 1952 Patent Act, which includes § 112. The case is also distinguishable on its facts. In *Permutit*, the free zeolite bed was separate from, and *not* inherent in, the water softening apparatus. *Id.* at 55. Here, the equiaxed microstructure is an inherent property of the silicon carbide ceramic body disclosed in the parent application. In addition, the absence in the *Permutit* patent of any reference to a free, rather than a locked, zeolite bed raised no implication that a free bed was important. *Id.* at 57. Here, one skilled in the art need not rely on implication—he will invariably obtain a silicon carbide ceramic body having an equiaxed microstructure if he follows the preferred teachings or any one of examples 1-30 set forth in the '954 patent.[10]

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[10] Kyocera's quotation from *Permutit* suggesting that drawings may not be used when interpreting the specification or claims is

(Footnote continued on following page)

Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47 (1938), is likewise not in conflict with the Federal Circuit's decision in this case. In *Schriber-Schroth*, although flexibility was apparently an inherent property of the material out of which the claimed webs were made, the specification expressly taught to the contrary that the webs were "extremely rigid". *Id.* at 55. Here, by contrast, the preferred teachings and examples 1-30 of the '954 patent all invariably lead to a silicon carbide ceramic body having an equiaxed microstructure. *See Ralston Purina Co. v. Far-Mar-Co, Inc.*, 586 F. Supp. 1176, 1219-20 (D. Kan. 1984), *modified on other grounds*, 772 F.2d 1570 (Fed. Cir. 1985) (distinguishing *Schriber-Schroth* on the same basis stated here and finding that an inherent disclosure was full support for a subsequent express disclosure).

In *General Electric Co. v. Wabash*, 304 U.S. 364 (1938), the description requirement was not even in issue. Rather, the Court was there concerned with the requirement, which now constitutes the *second* paragraph of § 112, that a patent application must contain claims "particularly pointing out and distinctly claiming" the invention. Thus, the Court considered whether or not the claims were too indefinite. *Id.* at 369. The Court's passing reference to the description in the specification, *id.* at 373, which was not an issue before the Court, was made in the context of its discussion of the claims. In this case, there is no dispute that, with the exception of the description requirement, *all* of § 112 is satisfied.

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[10] *continued*
inapposite. Here there is not an "entire absence of description of the invention" as there was in *Permutit*. *Id.* at 60. Rather, in this case there is an inherent disclosure of a property of the invention.

Kyocera's petition also refers to a CCPA decision, *Langer v. Kaufman*, 465 F.2d 915 (C.C.P.A. 1972). Again, Kyocera demonstrates its lack of conviction by stating that *Langer* is "apparently" irreconcilable with the Federal Circuit's decision here. (Pet. at 20) As the Federal Circuit has already explained, there is no inconsistency between *Langer* and this case; *Langer* was an interference case which concerned a different issue, constructive reduction to practice of the invention. (App. B10-B11) In addition, in *Langer* the court held that there was no inherency because the inventor did not appreciate the invention embodied in the product described in the parent. *Id.* at 918. Indeed, "[a]ll the other evidence [was] to the contrary." *Id.* at 920. In this case, however, Kyocera has admitted that the Kennecott inventors knew they had obtained an equiaxed microstructure before the application for the '954 patent was even filed.

Furthermore, the "necessary and only reasonable construction" language in *Langer*, relied on by Kyocera, refers to predictability of result. Thus, as explained in *Langer*, "[t]he '488 specification disclosure does not necessarily lead to the conclusion that the Run E was the gamma form. It could have been one of the other purple forms." *Id.* at 918. By contrast, here Kyocera has admitted that there is absolute predictability of result if one skilled in the art follows the preferred teachings or repeats any one of examples 1-30 of the '954 patent.

Kyocera has failed to raise even the slightest suggestion of a conflict between the Federal Circuit's decision here and the prior decisions of this Court or any other tribunal.

D. The Federal Circuit Reached A Fair Decision

The Federal Circuit's decision recognizes the flexibility that inventors must be permitted in describing and claiming their inventions. In addition, it is in harmony with the fundamental principles of United States patent law that a patent is presumed valid and that the party alleging patent invalidity bears the burden of proof, and that burden never shifts. 35 U.S.C. § 282.

Because the Federal Circuit found that the inherent disclosure in this case was adequate, this does not mean that there are no limits on the doctrine of inherency. Rather, the inherent disclosure was acceptable here because of the very important admitted facts, which included contemporaneous appreciation, invariability of result, and the knowledge of those in the ceramics art that silicon carbide ceramic bodies may have equiaxed microstructures. (App. B4) It was further admitted that as a matter of course, such a person skilled in the art would examine the microstructure of a new ceramic body and, in this case, would find an equiaxed microstructure. Based upon these facts, the Federal Circuit was satisfied that the necessary information was reasonably conveyed to one of skill in the art, and the inherent disclosure met the description requirement.

Such a result was eminently reasonable and fair because possession of the invention was ensured, obtaining an equiaxed microstructure was inevitable, and an understanding of the invention by one skilled in the art was purely routine. Thus, application of the doctrine of inherency in no way sacrificed the purpose underlying the description requirement.

E. Any Result Other Than That Reached By The Federal Circuit Would Create Chaos In Patent Law

Particularly since it was the basis of the Federal Circuit's decision, it is of marked interest that Kyocera's petition does not address the doctrine of inherency. Perhaps one reason why the petition avoids any such discussion is, as noted above, that Kyocera is essentially advocating the destruction of the doctrine of inherency. Such a result would have a calamitous effect on patent law as it is presently understood and practiced and as it has in the past been understood and practiced.

If there were no doctrine of inherency, inventors would be strictly confined to unreasonably narrow rules for describing their inventions and any deviations therefrom, however slight, would result in a loss of patent rights. This would hardly fulfill the intention of the Framers of the Constitution who gave Congress the power "to promote the Progress of Science and useful Arts . . .", U.S. Const. art I, § 8, cl. 8, nor the intention of Congress which exercised its power by enacting a broadly worded description requirement.

In addition to placing in jeopardy innumerable extant patents, destruction of the doctrine would overrule an unbroken line of well-reasoned, fair, and consistent authority. This authority would be replaced by precedent that would encourage patent infringers to take advantage of a technical loophole and to freely reap the benefits of other persons' inventions, which are the result of substantial investments of energy, time, and money.

F. Kyocera's Petition Is Without Merit

Three of the basic flaws of Kyocera's petition have already been noted—its premise that the invention is not disclosed in the '954 patent, its failure to recognize or discuss the doctrine of inherency, and its attempt to read a "four corners" limitation into the description requirement.

In addition, Kyocera tries to build a case by noting that predecessor statutes to the 1952 Patent Act also had description requirements. Such discussion does little to advance its position, however. In his concurring opinion in *In re Barker*, Judge Rich, now of the Federal Circuit, responded with skepticism to the majority's similar analysis of the predecessor description requirements. *In re Barker*, 559 F.2d 588, 594 (C.C.P.A. 1977), *cert. denied*, 434 U.S. 1064 (1978) (Rich, J., concurring). He even noted that though some of the words from predecessor statutes were carried over into § 112, "they are inappropriate to some situations . . ." *Id.* Indeed, perhaps what is most notable about Kyocera's historical view is that it clearly shows that the description requirement has always been very broadly worded and that there is not now and never has been any "four corners" restriction in § 112. *See Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980).

Kyocera's petition also erroneously requires that the purpose of § 112 *as a whole* be fulfilled by the description requirement alone. In fact, however, § 112 also contains enablement, best mode, and definiteness requirements, each of which also contributes to the overall purpose of § 112 that an inventor inform the public of his invention in exchange for a patent and its accompanying rights of exclusion. There is no dispute that the '954 patent satisfies each of these other requirements.

Kyocera's petition lacks force and credibility because it is misleading, and it is premised on erroneous assertions. In sum, the petition is without merit.

CONCLUSION

Kyocera's petition asks this Court to overturn an established line of authority through which the doctrine of inherency has flourished. The doctrine of inherency is necessary and it is fair. Accordingly, the writ should be denied.

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